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PATENT
Docket No.: 020891-001411US

TOWNSEND and TOWNSEND and CREW LLP

By: 

Lukas K. Szymanski

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Roland W. Burli et al.

Application No.: 10/523,422

Filed: October 6, 2005

For: Biaryl Compounds Having Anti-
Infective Activity

Customer No.: 20350

Confirmation No.: 1167

Examiner: Nolan, Jason Michael

Art Unit: 1626

REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT
DETERMINATION
UNDER 37 C.F.R. § 1.705(b)

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.705(b), Applicants respectfully request reconsideration of the patent term adjustment determination. This request is accompanied by the fee set forth in §1.18(e) and a statement of facts as required under 37 C.F.R. § 1.705(b)(2).

Statement of Facts

Correct Patent Term Adjustment and the Bases Under § 1.702 for the Adjustment

The correct patent term adjustment is 414 days, not 344 days as stated on the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed on September 17, 2008.

The period of adjustment under 37 C.F.R. § 1.702(a) is 404 days ("A delay").

The period of adjustment under 37 C.F.R. § 1.702(b) is to be determined when the instant application issues. The current effective period of adjustment as of December 15, 2008 under 37 C.F.R. § 1.702(b) is 70 days ("B delay"). Applicant submits that pursuant to 1.702(b), the total period of adjustment continues from this date, December 15, 2008, the date of the instant petition and concurrent submission of the issue fee payment. Applicant is entitled to additional adjustment days until the date of the patent issuance pursuant to 1.702(b).

The period adjustment under 37 C.F.R. § 1.704(a) is 60 days ("applicant delay").

The period adjustment under § 1.703(f) is 414 days ("A delay + B delay – Applicant delay").

The relevant dates as specified in 37 C.F.R. §§ 1.703(a)-(e) & the adjustment specified in 37 C.F.R. § 1.703(f)

1. § 1.703(a)

Applicants are in agreement with the USPTO determination of a period of adjustment of 404 days under 37 C.F.R. § 1.703(a).

Applicants respectfully request an additional period of adjustment equal to the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid, December 15, 2008, and all outstanding requirements were satisfied and ending on the date the patent was issued. *See* 37 C.F.R. § 1.703(a)(6).

2. § 1.703(b)

The period of adjustment under 37 C.F.R. § 1.702(b) begins on the day after the date that is three years from the filing date of the instant application, October 6, 2008, and ends on the day the patent is issued.

3. § 1.703(c)-(e)

There are no relevant dates as specified under § 1.703(c)-(e).

4. § 1.703(f)

The period of adjustment under 37 C.F.R. § 1.702(f) is 474 days, *i.e.*, 404 days of A delay plus 70 days of B delay.

There are no overlapping periods under §§ 1.703(a)-(e).

Applicants request that overlapping periods be determined in accordance with *Wyeth v. Dudas* (Case No. 07-1492, D.D.C. 2008). The periods of delay under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) overlap only if they occur on the same calendar day or days.

As discussed above, Applicants respectfully request an additional period of adjustment equal to the number of days, if any, under 37 C.F.R. § 1.703(a)(6). Any such period of adjustment under 37 C.F.R. § 1.703(a)(6) begins on October 6, 2008 will not overlap with a period of adjustment under 37 C.F.R. § 1.702(b).

Patent Term Adjustment Determination

Currently as of December 15, 2008 applicants are entitled to 414 days of patent term adjustment, *i.e.*, [474 days (A delay + B delay)] minus [60 days (applicant delay)]. Applicants are also entitled to any period of adjustment under 37 C.F.R. § 1.703(a)(6).

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Please charge the fee set forth in 37 C.F.R. §1.18(e) (\$200.00) to Deposit Order Account No. 20-1430. Please charge any necessary additional fees or credit any overpayments to our Deposit Order Account No. 20-1430.

Terminal disclaimer

Assignees of the instant application note that no terminal disclaimer has been filed in the above referenced application at this point. Applicants note that US Patent Nos. 7,179,892 and 7,189,819 are the patents at issue in *Wyeth v. Dudas* which is currently being appealed by the PTO. Hence the final expiration dates of these patents has not yet been determined.

Based on the foregoing, Applicants respectfully request reconsideration of the patent term adjustment determination.

Respectfully submitted,



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